UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,671	04/16/2004	Michael Chen	BPCUR0007MC (C-52)	9595

27939 7590 06/22/2010

PHILIP H. BURRUS, IV
460 Grant Street
Atlanta, GA 30312

EXAMINER	
PARRA, OMAR S	

ART UNIT	PAPER NUMBER
2421	

MAIL DATE	DELIVERY MODE
06/22/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/826,671	CHEN ET AL.	
	Examiner	Art Unit	
	OMAR PARRA	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 March 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,5,7-11,13,18-25,27-32,37,41-43 and 48-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,5,7-11,13,18-25,27-32,37,41-43 and 48-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 4, 5, 7-11, 13, 18-25, 27-32, 37, 41-43 and 48-52 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims **1, 4, 5, 7-10, 13, 18-25, 27-32, 37, 38, 41-43, 48-50 and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047) in view of O'Kane (Pub. No. 2003/0105831).

Regarding claims 1, 25 and 27, Plotnick teaches an apparatus for creating at least one targeted integrated image for delivery to a user **(130, Fig. 1; [0037]; [0039]; where the content provider 130 selects advertisements and send them along with the content, [0085])**, the apparatus comprising:

a processor for determining content of potential interest to the user based on at least one user preference **(The ads for selection are placed in queue or playlist from which the headend picks commercials. This queue includes targeted commercials that include at least one user preference, [0087]; [0101]; [0105]-**

[0106]). Given that the data to generate the queue -Universal Ad Queue, UAQ- is retrieved from a database and that the ads have pointers to be selected,[0039; [0057], it is inherent that at least one computer processor has to perform all the selection of the targeted ads), prior to or during the user's request for a first image comprising a video file or while the user is receiving the first image **(The selection of ads can be dynamic or it can follow a predetermined order of insertion, [0055]; [0556]; [0059])**, and

selecting a second image comprising a barker advertising the content of potential interest to the user from barker advertisements remaining in the queue **(different type of advertisements are chosen to be combined to the content: overlay ads, advertisement bugs, product placement ads, programming ads, VOD or PPV ads, etc, which are selected from the UAQ for presentation and put together with the content, [0047]-[0050])**, and wherein the processor determines the content of potential interest to the user that has not previously been viewed by the user **(One of the features of the UAQ is that it keeps track of what ad was already played and puts it at the end of the queue to make sure it does not repeat and other fresh ad is played next, [0058]; [0061]);**

a combiner for combining the second image with the first image to form a targeted integrated image for delivery to the user **([0012]; [0047]-[0050]; [0085]; [0109], where ads are inserted in the delivered content, and therefore, an inherent inserter or combiner must exist)** and wherein the combiner inserts the second image within the first image.

Additionally, Plotnick teaches that the at least the one user preference comprises content ordering habits of the user **([0101]; [0104]; [0105]).**

On the other hand, although Plotnick teaches removing commercials off the UAQ based on different criteria ([0061]; [0081]). Plotnick does not explicitly teach determining content previously ordered or viewed by the user and removing from a queue barker advertisements corresponding to the content previously viewed by the user.

However, in an analogous art, O'Kane teaches a system that provides commercials associated to the distributed content (music or video). O'Kane teaches that once the commercial is played with its associated content, the commercial is deleted ([0075]-[0077]).

Therefore, it would have been obvious to one of ordinary skill in the art to have modified Plotnick's invention with O'Kane's feature of deleting the commercial once an associated content has been played for the benefit of narrowly targeting commercials and at the same time giving more space on the memory for new advertisements.

Regarding claims 4 and 28, Plotnick and O'Kane teach wherein content ordering habits includes at least one of information indicating times at which the user previously viewed or ordered content, genres of content previously viewed or ordered by the user, characteristics of content previously viewed or ordered by the user, and menu selections made by the user **(Plotnick: [0083]; [0084]; [0101]; [0104]; [0105]).**

Regarding claims 5 and 29, Plotnick and O'Kane teach further comprising determining an identity of the user, wherein the content of potential interest to the user is determined based on an at least one user preference associated with the identity of the user **(Plotnick: the ads of the queues are generated for a specific subscriber, 1 or 2, Fig. 20; [0148]-[0149]).**

Regarding claims 7 and 31, Plotnick and O'Kane teach further comprising determining images available in the queue **(advertisement on the queue are available for presentation; [0055]-[0059])**.

Regarding claims 8 and 32, Plotnick and O'Kane teach further comprising: marking the second image delivered to the user as having been delivered; and placing the marked image at the end of the queue, wherein the step of selecting selects images sequentially from the beginning of the queue **(Plotnick: [0055]; [0056]; [0061]; where the ads will be played in order unless there is a preference or weight for their presentation, at least in [0059]-[0060])**.

Regarding claim 9, Plotnick and O'Kane teach wherein the first image includes at least a menu or a programming guide **(Plotnick: [0051]; [0055]; [0056])**.

Regarding claim 10, Plotnick and O'Kane teach wherein the step of determining is initiated in response to the user accessing the menu or programming guide **(Plotnick: [0056])**.

Regarding claims 13 and 37, Plotnick and O'Kane teach wherein the step of determining is initiated responsive to the user requesting the video content **(Plotnick: [0038]-[0039]; [0047]-[0050]; [0059])**.

Regarding claims 18,19, 38, 41 and 42, Plotnick and O'Kane teach further comprising repeating the steps for creating at least one new integrated image for delivery to the user as the user continues to request or receive images **(As seen on Fig. 20, the integration of ads is repeated while the subscriber 1 keeps watching ABC. Given that queues are used for integrating commercials to content, and given that there is a plurality of ads in a queue, the process of integrating the ads and content has to repeat at least once more; [0054]-[0055]; [0059]).**

Regarding claims 20 and 43, Plotnick and O'Kane teach wherein the steps are recursively repeated for delivering new integrated images for delivery to the user **(The UAQ is generated periodically, [0081], and therefore, the integration of ads and content for delivery is repeated recursively).**

Regarding claim 21, Plotnick and O'Kane teach further comprising compressing at least one of the first image or the second image, prior to forming the integrated image **([0045])**.

Regarding claim 22, Plotnick and O'Kane teach wherein the step of combining includes inserting the second image within the first image wherein the first image is adapted to appear to the user to be paused **([0139]-[0140])**.

Regarding claim 23, Plotnick and O'Kane teach wherein the first image is adapted, for delivery to the user, to appear to be paused **(The PVR functions can be performed at the headend [0121]; therefore, the video content is delivered trick-played, i.e. paused, [0139]-[0140])**.

Regarding claim 24, Plotnick and O'Kane teach wherein the first image is adapted, upon delivery to the user, to appear to be paused **(The PVR functions can be performed at the user subscriber's location [0121]; therefore, the trick play features are performed at the local PVR, and the content is not delivered like that, i.e. paused, [0139]-[0140])**.

Regarding claims 30 and 52, Plotnick and O'Kane teach wherein the integrated image is configured to appear as a picture-in-picture display with the barker advertising the content of potential interest to the user presented as a first picture within a second picture of the video file **(For trick play content -content that allow pausing, rewind, skip, etc- an alternate advertisement –video ad- is presented on top of the tricked video file as a picture-in-picture, [0139]-[0140]. The PVR functions can be implemented entirely at the headend [0121])**.

Regarding claim 48, Plotnick and O'Kane teach wherein the integrated image is configured to appear as a picture-in-picture display in accordance with predetermined rules **(On VOD or PPV content, picture-in-picture ads are presented following certain rules, [0138]-[0140])**.

Regarding claim 49, Plotnick and O'Kane teach wherein the predetermined rules comprise presenting the barker advertising the content of potential interest to the user during an introduction of the video file **(VOD or PPV ads can be presented before the program or at the end of the program [0048])**.

Regarding claim 50, Plotnick and O'Kane teach wherein the predetermined rules comprise presenting the barker advertising the content of potential interest to the user during credits of the video file **(VOD or PPV ads can be presented before the program or at the end of the program [0048])**.

4. Claim **11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047) in view of O'Kane (Pub. No. 2003/0105831) in further view of Knudson et al. (hereinafter 'Knudson', Pub. No. 2003/0110499).

Regarding claim 11, Plotnick and O'Kane teach all the limitations of the claim it depends on. On the other hand, although Plotnick and O'Kane teach determining ads based on user's viewing habits, Plotnick and O'Kane do not explicitly teach monitoring user's menu or programming guide selections as the user navigates through the menu or programming guide.

However, in an analogous art, Knudson teaches a system for targeting advertisement to users (title; Abstract; [0011]). In order to target advertisement to users, Knudson teaches to monitor all the interactions of the user with the program guide ([0011]; [0071]), since the user's interactions with the program guide are indicative of the user's interest ([0005]). Knudson teaches that one of the user's monitored actions is the user navigation on the EPG ([0072]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Plotnick and O'Kane's invention with Knudson's monitoring of user's navigation interaction with the program guide for the benefit of using all or as many of the resources to get user's preference for a more accurate advertisement targeting.

5. Claim **51** is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047) in view of O'Kane (Pub. No. 2003/0105831) in further view of Sie et al. (hereinafter 'Sie', Pub. No. 2004/0030599).

Regarding claim 51, Plotnick and O'Kane teach all the limitations of the claim it depends on. On the other hand, Plotnick and O'Kane do not explicitly teach wherein the barker advertising the content of potential interest to the user has a first genre associated therewith, wherein the video file has a second genres associated therewith, wherein the determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user comprises selecting the first genre so as to be different from the second genre.

However, in an analogous art, Sie teaches a system that integrates served content with commercials (Abstract). Sie teaches monitoring user viewing habits and being able receive user's inputs ([0086]-[0090]). Sie teaches categorizing commercials, and if it is determined that the commercial should not be presented according to user's profile, even if a content with that category is chosen, a commercial under that category will be automatically skipped and will not be chosen, and instead, another commercial will be utilized ([0150]-[0151]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Plotnick and O'Kane's invention with Sie's feature of automatically not choosing or skipping a commercial when the category of the commercial and the content are the same and not allowed for the benefit of not showing commercials with categories not allowed when a program disliked by the user has been selected by mistake.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR PARRA whose telephone number is (571)270-1449. The examiner can normally be reached on 9-6 PM (M-F, every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

OP